

REMARKS

Claims 1-18 are pending in this application. By this Amendment, claims 6-18 are added. Support for added claims can be found in Figs. 4 and 7, for example. Claims 1, 3 and 10 are independent.

Allowable Subject Matter

Applicants appreciate that claims 1 and 2 are allowed, and claims 4 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the features of the base claim and any intervening claims. However, it is submitted that claim 3 is also allowable in view of the following remarks.

Claim Rejection – 35 U.S.C. § 102

Claim 3 is rejected under 35 U.S.C. § 102(e) as being anticipated by Shore et al. (hereinafter “Shore”), U.S. Patent Publ. No. US 2003/0011692 A1. The rejection is respectfully traversed.

Shore fail to disclose or suggest “a focus position storage device which stores a desired focus position ... as a focus stored position”, as recited in claim 3.

The Examiner alleges that the microprocessor 304 in Shore “*inherently* requires a focus position storage device to store the distance value which represents a desired position of the focus lens” (emphasis added). However, it is submitted that it would not be inherent for the microprocessor 304 of Shore to necessarily employ a focus position storage device. The fact that a certain result or characteristic may occur or be present

in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Reijckert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (rev'd rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art). Thus, Applicants respectfully traverse that the focus position storage device is not inherently taught in the microprocessor of Shore.

For argument sake, it is assumed that the microprocessor of Shore discloses a focus position storage device, the microprocessor of Shore does not teach that the focus position storage device stores a desired focus position. Shore merely discloses that the microprocessor 304 includes a lens data table 310 that relates to only a digital position data of the optical properties of the lens (paragraph [0023]), rather than relating to storing a desired focus position.

By storing the desired focus position, it may be possible, for example, to accurately focus on a subject during test photographing using an auto focus function and then to reproduce, during actual photographing, the focus position obtained during the test photographing by manual focusing.

Accordingly, Shore fail to disclose or suggest "a focus position storage device which stores a desired focus position ... as a focus stored position", as recited in claim 3.

Thus, Applicants submit that claim 3 is allowable over the prior art. Claims 6-9 are allowable by virtue of their dependency on claim 3. Withdrawal of the rejection is respectfully requested.

Independent claim 10, which similarly recites some of the allowable features found in claim 1, is also allowable, along with dependent claims 11-17.

Comments on Reasons for Indication of Patentability

In reply to the Examiner's Statement of Reasons for Indication of Patentability, Applicants submit the following comments.

The Examiner offers reasons why the claims of the present application are allowable over the prior art of record. Although Applicant agrees that the various claimed limitations mentioned in the claims are not taught or suggested by the prior art taken either singly or in combination, Applicants wish to emphasize that it is the language of each claim, including the interrelationships and interconnections between various claimed elements which is allowable over the prior art of record, and not the Examiner's paraphrasing of claim features which are not present in any of the allowed claims.

CONCLUSION

In view of the above amendments and remarks, reconsideration and allowance of each of claims 1-18 is earnestly solicited.

If any matters remain at issue in the application, the Examiner is invited to contact the undersigned at (703) 668-8000 in the Northern Virginia area, for the purpose of a telephonic interview.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.

By



John A. Castellano
Reg. No. 35,094

P.O. Box 8910
Restons, VA 20195
(703) 668-8000

JAC/DJC:ewd